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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,302	12/12/2001	Matthias Stefan Bierbrauer	DE920000113US1	5653
25259	7590	03/15/2004	EXAMINER	
IBM CORPORATION 3039 CROWN WALLIS RD. DEPT. T81 / B503, PO BOX 12195 REASEARCH TRIANGLE PARK, NC 27709			HONG, STEPHEN S	
		ART UNIT		PAPER NUMBER
		2178		7
DATE MAILED: 03/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/015,302	BIERBRAUER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Stephen S. Hong	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. This action is responsive to amendment received on 8/25/03.
2. The rejections of claims 1-2, 4 and 6-8 under 35 USC 102(e) as being anticipated by Woltz et al. and claims 1, 3, 5 under 35 USC 103(a) as being unpatentable over Malik have been withdrawn as necessitated by the amendment.

### *Priority*

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-8 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Note that independent claims 1, 6, 8 still claim the feature of "the stub containing at least information to enable automatic retrieval of stored document from the repository." In contrast, dependent claims 2, 4, 7 claim that only a portion from the document from the repository is retrieved and inserted into the stub document. The limitation from the independent claims and the dependent claims contradict each other, since the independent claims state that the whole document is retrieved from the

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repository but the dependent claims state that only portions of the document are retrieved from the repository. There is even significant problem with the claims as explained with respect to 23 USC 112, first paragraph below.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-8 are rejected, as necessitated by the amendment, under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As explained with respect to the 35 USC 112, second paragraph, above, the claims are indefinite as to what is being retrieved from the repository. In the specification, on page 6, in the last paragraph (in "Retrieving Archived Documents by Overwriting Stubs" section) apparently discusses this processing. It states:

Once a stub is found after a predescribed search, a user can retrieve the corresponding archived (complete) document, CSLD extracts the archive ID from the stub document, and retrieves the document from the archive using the archive ID. Then, the content of the archived document is re-inserted into the stub document. This will restore the original document completely.

D

Note that the Specification contracts itself as well. It says that the "archived (complete) document" is retrieved from the repository. If this complete document is "re-inserted" into the stub document, then the resulting product is not the original document. The complete document is the original document, and thus, the complete document added

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into the stub document is the original document plus the stub document, which apparently is a stripped down version of the original document.

May be the statement from the above paragraph, "the content of the archived document is re-inserted into the stub document" is used to allege that "the content" is "portions of the document." However, such assumption is improper, since 35 USC 112, first paragraph, requires that the specification include a description of the invention that is "full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains." Clearly, the specification does not provide such clear description.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Beyda et al., U.S. Pat. No. 6,505,237 B2, 1/03.

As per claims 1-8 Beyda teaches the following claimed features:

- storing a copy of an original document from the document processing system in the repository (col.4, lines 15-43; "The email message is first transmitted to a person who accesses email via the local router/server 12", "email messages, including any attached files, that have been received and stored at the local router/server 12");
- stripping content from the original document in the document processing system to form a stub document, the stub document containing at least information to enable automatic retrieval of the stored document from the repository when the stub document is selected by a user (col.4, line 63, "the client devices 14, 16, and 18 may be configured to download only the email message and not the attached file"); and
- maintaining the stub document in the document processing system (since the stub documents are stored in the client devices 14, 16, and 18);
- wherein the stripping preserve a unique document identifier in the stub document to keep a link to the stored document valid, and retrieving the stored document from the repository when a user attempts to open the stub document (col.5, line 44, "Other attachments are downloaded only upon command by the receiving party", since the user must first open the stub document to retrieve the attached file.).

***Response to Arguments***

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10. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,505,236 B1 Pollack Network-based mail attachment storage system and method.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen Hong  
Primary Examiner  
Art Unit 2178  
March 11, 2004.